



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/696,666 | 10/29/2003 | Susumu Yamada | S008-P03193US | 6837 |
| 33356 | 7590 | 05/22/2006 | EXAMINER | |
| SoCAL IP LAW GROUP LLP 310 N. WESTLAKE BLVD. STE 120 WESTLAKE VILLAGE, CA 91362 | | | TIBBITS, PIA FLORENCE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2838 | |

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,666

Applicant(s)

YAMADA ET AL.

Examiner

Pia F. Tibbits

Art Unit

2838

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other. _____

DETAILED ACTION

This Office action is in answer to the amendment filed 10/11/2005. Claims 1-10 are pending, of which claims 1-9 are amended, and claim 10 is added.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter: "serial-parallel converting data", "parallel-serial converting data", "data received from the outside", etc. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention: "serial-parallel converting data", "parallel-serial converting data". To continue prosecution it was assumed that the battery controller communicates/receives information.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: "data received from the outside" is indefinite, as "outside" implies anything other than the battery, and lacks antecedence in the specification. To continue prosecution it was assumed that the battery is controlled by a controller of the device it powers.

Art Unit: 2838

The above are but a few specific examples of indefinite and functional or operational language used throughout the claims, and are only intended to illustrate the extensive revision required to overcome the rejections under 35 USC 112. The above-mentioned corrections therefore, are in no way a complete and thorough listing of every indefinite and functional or operational language used throughout the claims. Applicant is required to revise all of the claims completely, and not just correct the indefinite and functional or operational language mentioned. The following art rejections are given in view of the above rejections of claims under 35 USC 112. Therefore, the following art rejections are applied only as far as the claims are understood in view of rejections made under 35 USC 112.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Applicant used repeatedly functional recitations in the claims, e.g., "for storing", "for controlling ", which broaden the scope of the claims. Therefore, at the outset, the examiner notes that claims are to be given their broadest reasonable interpretation during prosecution. *In re Zletz*, 893 F 2d 319, 321, 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989); *In re Pratner*, 415 F 2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969); *In re Yamamoto*, 740 F 2d 1569, 222 USPQ 934 (Fed. Cir. 1984); *Burlington Indus. V. Quigg*, 822 F 2d 1581, 3 USPQ 1436 (Fed. Cir. 1987); *In re Morris*, 43 USPQ 2d 1753, 1756 (Fed. Cir. 1997). In responding to this Office action, applicants are reminded of the requirements of 37 CFR 1.111 and 1.119 that applicants specifically point out the specific distinctions believed to render the claims patentable over the references in presenting responsive arguments. See MPEP 714.02. The support of any amendments made should also be specifically pointed out. See MPEP 2163.06.

During patent examination, the pending claims must be "given their broadest reasonable interpretation **consistent** with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Brotto discloses in figures 1-4 a battery 30 comprising a storage section 33 for storing information relating to the battery 30; the battery 30 controller communicates/receives information relating to the battery read out from the storage section for transmitting to the outside/tool 40/reader 50/computer 50, a communication control circuit 31 for controlling storing the data in the storage section [see column 2, lines 59-67] and reading out the data from the storage section [see column 2, lines 49-52].

As to claim 2, Brotto discloses a register/"string" of memory slots [see column 2, line 60] for holding data to be stored at a designated address [see column 2, lines 59-67]. As to an address decoder for designating an address at which the data is stored in the storage section: Brotto discloses controller 21 can designate a string of memory slots, or "buckets," for storing related information. Therefore, it is an inherent function of the battery controller to include an address decoder in order to continuously designate the memory slot/"bucket" where the information is to be stored, and MPEP 2100 states that the disclosure of a limitation may be expressed, implicit or **inherent**. As to wherein the communication control circuit is adapted to set address data indicating the address in the address decoder and sets the data in the register: Brotto discloses a string of memory slots of memory 25 may be organized into buckets, each bucket representing a different set of data [see column 2, lines 59-67].

As to claims 3-10, see remarks and reference above.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection. Applicant amended the claims to include a "conversion circuit", "serial-parallel converting data", "parallel-serial converting data", etc. which is new issue.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related apparatus: **Schwendeman** [5440299] discloses an address decoder for a battery, **Mann et al.** [5754029], **Kumar et al.** [6018227] [6160376][6331761] disclose a charger and a complementary battery pack that, collectively, provide information about the charge state and history of the battery pack.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Pia Tibbits whose telephone number is (571) 272-2086. If unavailable, contact the Supervisory Patent Examiner Karl Easthom whose telephone number is (571) 272-1989. The Technology Center Fax number is (571) 273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 10/696,666

Page 6

Art Unit: 2838


you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PFT

May 13, 2006

Pia Tibbits

Primary Patent Examiner

A handwritten signature in black ink, appearing to be 'Pia Tibbits', written over the printed name.